UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/042,822	01/08/2002	Fung-Jou Chen	13,042.4	9638

23556 7590 06/29/2005

KIMBERLY-CLARK WORLDWIDE, INC.
401 NORTH LAKE STREET
NEENAH, WI 54956

EXAMINER	
STEPHENS, JACQUELINE F	

ART UNIT	PAPER NUMBER
3761	

DATE MAILED: 06/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/042,822	CHEN ET AL.	
	Examiner	Art Unit	
	Jacqueline F. Stephens	3761	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *08 April 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *36,37 and 40-48* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *36, 37, 40-48* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 4/8/05 have been fully considered but they are not persuasive.

Regarding the rejection of claims 36, 37, and 40-49 under 35 U.S.C. 112, first paragraph, applicant argues the specification discloses how to make and use the invention by the disclosure of an example (specifically example 2). The physical characteristics, i. e. the Wet Compressed Bulk must be determined by a test used to measure such characteristic. The scope of the claims is enabled to the extend the test, i.e. the method and equipment or parameters thereof, measuring such characteristic is described or disclosed. Applicant argues the specification and claims of the present invention are such that a person having ordinary skill in the art would understand with reasonable certainty the meaning of the specification and the claims and that no undue experimentation would be required to make and use the present invention. However, claims set forth the physical characteristics desired of the absorbent web rather than the specific composition and structure of the flap in the end product. Therefore, relying on Ex parte Slob, 157 USPQ 172, such claims could cover any conceivable combination of materials whether presently existing or which might be discovered in the future and which would impart the desired characteristic, i.e. the claims are too broad and indefinite since they purport to cover everything having the characteristics regardless of its composition. For these reasons, the examiner concludes the specification fails to teach how to make and use the claimed invention without undue experimentation or that

the scope of enablement provided to one skilled in the art is not commensurate with the scope of protection sought by the claims.

Applicant's arguments with respect to the rejection of claims 36, 37, and 40-48 have been considered but are moot in view of the new ground(s) of rejection.

Specification

a. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. The following is a quotation of 37 CFR 1.71(a)-(c):

(a) The specification must include a written description of the invention or discovery and of the manner and process of making and using the same, and is required to be in such full, clear, concise, and exact terms as to enable any person skilled in the art or science to which the invention or discovery appertains, or with which it is most nearly connected, to make and use the same.

(b) The specification must set forth the precise invention for which a patent is solicited, in such manner as to distinguish it from other inventions and from what is old. It must describe completely a specific embodiment of the process, machine, manufacture, composition of matter or improvement invented, and must explain the mode of operation or principle whenever applicable. The best mode contemplated by the inventor of carrying out his invention must be set forth.

(c) In the case of an improvement, the specification must particularly point out the part or parts of the process, machine, manufacture, or composition of matter to which the improvement relates, and the description should be confined to the specific improvement and to such parts as necessarily cooperate with it or as may be necessary to a complete understanding or description of it.

The specification is objected to under 37 CFR 1.71 because the specification fails to adequately teach how to make and/or use the invention.

Applicant has claimed a number of test results that the article exhibit. Applicant has not disclosed one example of combination of materials and structure that allow the claimed results to occur. No best mode has been disclosed by the applicant. What is the structure of the invention and materials used that allow the web to exhibit the claimed wet compressed bulk of claim 1. Making an invention consistent with the claims would involve undue experimentation. Applicant has not given any guidance as to how to make a web that would have the claimed results.

3. Claims 36, 37, 40-48 are rejected under 35 U.S.C. 112, first paragraph, because the best mode contemplated by the inventor has not been disclosed. Evidence of concealment of the best mode is based upon the fact that there is not an example provided in the specification of the structure and materials used that would provide the article with the claimed test results.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of

the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 36, 37, 40-42, 44, 45, and 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ahr et al. USPN 5763044.

As to claim 36, Ahr discloses a method for producing an absorbent web having a dry feel when wet (Abstract) comprising the steps of: preparing an inherently hydrophilic basesheet comprising papermaking fibers (col. 6, lines 40-45) and having an upper surface and a lower surface, the upper surface having a surface and having elevated and depressed regions (Figure 7); and depositing hydrophobic matter (col. 5, lines 63-65) preferentially on the elevated regions of the upper surface of the base sheet (Figure 7). Ahr provides good dispersibility as well as god mechanical integrity with the use of a wet strength resin. Compressed bulk would have been obvious by optimizing the wet strength additive (col. 5, lines 20-30), since the structure of the web is similar to the present invention.

As to claim 37, Ahr incorporates by reference (col. 4, lines 49-55) Benz USPN 3881987 who discloses a method of making an apertured topsheet involving the steps of depositing an aqueous slurry of cellulosic fibers on a foraminous web to produce an

embryonic web; molding the web on a three-dimensional substrate; and drying the web (Ahr col. 4, lines 49-66 and Benz col. 11, line 56 through col. 14, line 8).

As to claim 40, Ahr discloses the base sheet is wetlaid (col. 4, lines 34-36).

As to claim 41, Ahr discloses the base sheet is airlaid (col. 4, lines 27-29).

As to claim 42, see Figure 7, the hydrophobic matter comprises fibrils **54**.

As to claims 43 and 46, Ahr does not disclose the exact amount of hydrophobic matter attached to the upper surface or the Rewet value. It is evident that Ahr has a value for this characteristic. Ahr recognizes that the choice of fibril length and fibril density (amount attached to the surface) can be varied and this will affect the rewet characteristics see col. 5, lines 59-60 where Ahr discloses the coice of fibril length and fibril density allows the rewet characteristics to be varied. Ahr, therefore recognizes the Rewet value is a result effective variable of fibril length and density. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the article of Ahr with the claimed amount of synthetic fibers attached to the upper surface and the claimed Rewet value, since discovering an optimum value of a result effective variable involves only routine skill in the art.

As to claim 44, see Figure 7, the hydrophobic matter comprises fibrils **54**, which extend into the apertures of basesheet **52**.

As to claim 45, Ahr discloses 9-400 apertures per square inch (the number of apertures corresponds to the number of protrusions per square inch), which is included in the range of 5-300 protrusions per square inch (col. 5, lines 4-6). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provided the claimed height, since discovering optimum or workable ranges involves only routine skill in the art.

As to claim 47, see Figure 7.

As to claim 48, Ahr discloses the basis weight of the base sheet is .058-14.6 g/m^2 (col. 10, lines 31-32), which is included in the range of from about 10-70 gsm. Ahr is silent on the basis weight of the hydrophobic matter. It is evident that Ahr has a value for this characteristic. Ahr recognizes that the choice of fibril length and fibril density, which is affected by the fibril basis weight, can be varied and this will affect the rewet characteristics (col. 5, lines 59-60). Ahr, therefore recognizes the function of the topsheet in terms of rewet, acquisition, and tactile feel is a result effective variable of fibril length and density. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the article of Ahr with the claimed basis

weight of the hydrophobic matter, since discovering an optimum value of a result effective variable involves only routine skill in the art.

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jacqueline F. Stephens whose telephone number is (571) 272-4937. The examiner can normally be reached on Monday-Friday 9:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Larry Schwartz can be reached on (571) 272-4390. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jacqueline F Stephens
Examiner
Art Unit 3761

June 23, 2005

Larry I. Schwartz
Supervisory Patent Examiner
Group 3700